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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,878	08/29/2003	Patrick Engelking	10022/306	9353
28164 7590 07/22/2009 ACCENTURE CHICAGO 28164 BRINKS HOFER GILSON & LIONE P O BOX 10395 CHICAGO, IL 60610				
EXAMINER NGUYEN, TAN D				
ART UNIT 3689		PAPER NUMBER		
MAIL DATE 07/22/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/651,878

Applicant(s)

ENGELKING ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23-25, 27-67 and 83-85 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15-21, 23-25, 27-67 and 83-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/29/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment of 4/24/09 has been entered.

Claim Status

2. Claims 1-9, 10-14 (withdrawn), 15-21, 23-25, 27-67, and 83-85 are pending. Claims 10-14 have been withdrawn. Claims 22, 26, 68, and 86 have been canceled. Current pending claims comprise 6 independent claims sets:

- 1) System¹: 1-9;
- 2) Computer readable storage media (CRSM): 15 -19;
- 3) Method¹: 20-21, 23-25, 27-46,
- 4) CRSM²: 47-61,
- 5) CRSM³: 62-67, 69-82, and
- 6) CRSM⁴: 83-85.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 4/29/09 was filed after the mailing date of the application on 08/29/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 20-21, 23-25 and 27-46** are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because the claimed invention fails to set forth a particular machine that is specifically

configured/programmed to carry out the claimed invention, i.e. "the processor automatically models the inputs and forms a". Specifically, the Examiner asserts that the current claim language can be interpreted that the user, is performing the claimed invention by inputting the modeling steps into the processor and manipulates the processor.

Further, applicant's method steps fail the second prong of the test because there is no transformation of the data. It is asserted that the data has not been transformed into another state or into another object.

6. Claims 3, 7-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to more than one class of statutory subject matter.

The independent claim 1 begin by discussing a system/apparatus, however dependent claims 3, 7-9 respectively use language that is used in the claims of a method, "for executing", "executes", "to transform ...". "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 112

7. Claims 1-9, 15-21, 23-25, 27-67, and 83-85 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In these claims, it's not clear how the "analyze/ing" function (element/step) and "model/ing" function (element/step) are carried out?

2) In these claims, it's not clear what is the result of the "analyze/ing" function (element/step) and what is the relationship between the "result" of the "analyze/ing" function with the "model/ing" function (element/step)?

3) Claims 7-8 are vague and indefinite since the dependent claims uses "method steps" such as "executes", in an apparatus claims. See IPXL Holdings. Va. Amazon.com (Fed. Circuit 2005). System claim that includes a method step is invalid as indefinite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-9, 15-19, 20-46, 47-61, 62-82 and 83-86 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over CALVER.

As of 4/29/09, independent system claim 1 is as followed:

1. (Currently Amended) A system for identifying a business organization transformation opportunity for a business organization that provides a product or service, comprising:

a) a **microprocessor** configured to receive ~~controller programmed for receiving at the system~~ a plurality of business organization data inputs corresponding to a first state of a first business organization function of the business organization, wherein the first business organization function is associated with providing the product or service, analyze ~~analyzing~~ at least one of the business organization data inputs in accordance with at least one industry threshold, and model ~~modeling~~ a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, associated with providing the product or service ~~with respect to a particular function of the business organization~~ responsive to the analysis;

~~a storage device coupled with the controller for storing at least one business organization data input received at the controller; and~~

b) a **display** ~~user interface~~ coupled to ~~[[with]]~~ the microprocessor to present a user interface that includes ~~controller for receiving and presenting data and information associated with to a user of the modeled business organization transformation opportunity scenario indicator.~~

Note: independent claim 1 is (appears to be) an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473,

1477-78, 44 USPQ2d 1429, 1431-32 (*Fed. Cir. 1997*). Apparatus claims cover what a device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990)*. Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAl, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "for identifying a business ... or service" carries no patentable weight.

It is first important to note that the use of the term "display" leaves open to interpretation whether "display" is a device or a software component. (defining "display" as "a displaying, or exhibition". Thus, under the broadest reasonable interpretation, the display is mere an object, item, figure, etc. and not a structural element of an apparatus.

Note: In claim 1, (b), the phrase "...to present a user...." is not a positively recited structure but, rather, is mere intended use of the display .

Also, the data relating to "a first state of a first business organization function of the business organization, wherein the first business organization function is associated with providing the product or service" is considered "non-functional descriptive data" (NFDm). When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard

claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the "data" relating to "data inputs", adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed." Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data.

Similarly, **CALVER** discloses a system, method, and CRSM for identifying a business organization transformation opportunity for a business organization that provides a product or service, comprising:

a) a **microprocessor** configured to receive a plurality of business organization **data inputs** corresponding to a first state of a first business organization function of the business organization, wherein the first business organization function is associated with providing the product or service, analyze at least one of the business organization data inputs in accordance with at least one industry threshold, and model a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, associated with providing the product or service responsive to the analysis; and

{see Figs. 16, "324 Take My Business to the Next Level", "Manage My Assets Better", Figs. 3, 4, 6, 9, "Applications", and 13-14, pars. [0132-0136], [0137-0142]}

b) a **display** coupled to the microprocessor to present a user interface that includes information associated with the modeled business organization transformation opportunity scenario.

{see Figs. 2, 3, 16, pars. [0132-0136], [0137-0142]}

Note that the term "threshold", which means "a level, point, or value about which something is true or will take place and below which it is not or will not", or "a point at which a physiological or psychological effect begins to be produced", or "inflection point", etc., this is a relative term and the function of "Take My Business to the Next Level", or "Manage My Asset Better", "Reduce My costs" reads over this "threshold" definition since a change is taking place to improve a condition. Alternatively, in view of the general teaching of "improving" my conditions, or "taking my business to a next

level", the use of any other similar term to reflect a change such as "threshold" would have been obvious as mere using other similar term for the same "changing" effect.

Moreover, this appears to be a computer-implemented system or "data processing" and limitation such as "threshold", "client data", etc, they are considered as non-functional descriptive material (NFD) on the data of "...", thus having no patentable weight. The mere insertion of "threshold" or "client data" data over "data" does not "impart functionality when employed as a computer component", thus having no patentable weight.

See MPEP 2106.01 "Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Note also that the term "scenario", which merely means "plan" or "outline for any proposed or planned series or events" or "script", is a relative term. This reads over "application" or subsequent services, applications or information to carry out the "request" on Figs. 16, as shown in Figs. 13-15, pars. [0132-0142]. Also, this term is considered as "NFD" material as indicated above. The last function calls for

"displaying the scenario (item or information)", And there are no specific functions/steps calling out for carrying out the "scenario" by using other functions or steps.

As for dep. claims 2-4, 9 (part of 1 above) which deal with types of business functions, scenarios, etc., these are taught in Figs. 12-14 and 16, and pars. [0139-0143]

As for dep. claims 5-6 (part of 1 above) which deal with types of business data inputs, etc., these are taught in Figs. 6, 12-14 and 16, and pars. [0139-0143].

As for dep. claims 7-8 (part of 1 above) which deal with types of execution of the microprocessor, these are taught in Figs. 6, 12-14 and 16, and pars. [0007], [0050-0052], and [0059-0067].

As for independent CRSM claims 15-19, Method claims 20, 21, 23-25, 27-46, CRSM 47-61, CRSM 62-67, 69-82 and CRSM 83-85, they are basically the CRSM, and method to carry out the method of claims 20-46 above, and are rejected over the CRSM and method claims of CALVER to carry out the rejections of system claims as shown on Figs. 2-5. In other words, these group of claims have similar scope to the system claims of 1-9, are rejected for similar reasons set forth in the rejections of claims 1-9 for convenience. As for the differences in the types of information, functions, etc., they are within the skill of the artisan and would have been obvious to make minor modifications within deviation from the main scope of CALVER as taught in [0143].

Response to Arguments

13. Applicant's arguments with respect to claims 1-9 and 15-86 have been considered but are moot in view of the new ground(s) of rejection which are caused by applicant's amendment of the claims.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

No claims are allowed.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).
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3. Any response to this action should be mailed to:
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4. In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.
5. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number **(571) 272-6806**. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at **(571) 272-6805**. The main **FAX phone** numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is **(571) 273-6806**. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689